



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Re Application of: Kontio : Attorney Docket No.: 944-005.020
Serial No.: 10/671,003 : Examiner: Michael Roswell
Filed: September 25, 2003 : Art Unit: 2173

For: USER INTERFACE ON A PORTABLE ELECTRONIC DEVICE

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed April 24, 2007 for the present application, please accept the enclosed corrected Brief of Appellants. The brief has now been revised to comply with required corrections.

The Examiner is invited to contact applicant's attorney if there are any questions.

It is believed that no fee is due with the submission of this paper, however, if any fee should be due of which the applicant is unaware, the Commissioner is hereby authorized to charge Deposit Account No. 23-0442 for any such fees.

Respectfully submitted,

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Cathy Sturmer



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BRIEF OF APPELLANTS (37 CFR §41.37)

Sir:

This is an appeal from the final rejection contained in a Final Office Action mailed on July 17, 2006 (the "Final Office Action"), rejecting claims 1, 3-7, 9-13 and 15.

I hereby certify that this correspondence is being deposited today, May 1, 2007, with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Cathy Sturmer

REAL PARTY IN INTEREST (37 CFR §41.37(c)(1)(i))

The real party in interest in this action is Nokia Corporation, Keilalahdentie 4, FIN-02150 Espoo, Finland, by virtue of the Assignment dated November 10 and 14, 2003. The Assignment was recorded in the U.S. Patent and Trademark Office on February 9, 2004.

I. RELATED APPEALS AND INTERFERENCES (37 CFR §41.37(c)(1)(ii))

There are no related appeals or interferences.

II. STATUS OF CLAIMS (37 CFR §41.37(c)(1)(iii))

The status of the claims is:

claims 1, 3-7, 9-13 and 15.

Claims pending: 1, 3-7, 9-13 and 15.

Claims objected to: none.

Claims rejected: 1, 3-7, 9-13 and 15.

Claims on appeal: 1, 3-7, 9-13 and 15.

III. STATUS OF AMENDMENTS (37 CFR §41.37(c)(1)(iv))

No amendment as to claims 1, 3-7, 9-13 and 15. has been filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 CFR §41.37(c)(1)(v))

Appellant's invention is directed to an electronic device having a touch screen and a method of interacting with an icon displayed on the touch screen. The electronic device is capable of carrying a command symbolized by the icon and also capable of providing a message associated with the command. The icon is displayed at a designated area of the screen so as to allow a user to interact with the icon by using a physical object. See page 5, lines 8-16.

The invention of claim 1 is directed to a method of interacting with the icon displayed on the touch screen in an electronic device. The method has the steps of:

1) contacting the screen at the designated area by the physical object (see page 5, lines 20-22); and

2) removing the physical object from the screen before a selected time has expired to cause the electronic device to carry out the command (see page 5, lines 22-24), or

3) keeping the physical object at the designated area longer than the selected time to cause the electronic device to provide the message (see page 5, lines 24-27), and

4) removing the physical object from the screen after step 3 to cause the electronic device to carry out the command (see page 6, lines 6-9), or

5) moving the physical object off the designated area while keeping the physical object on the screen after step 3 to end the message (see page 6, lines 9-12).

In the invention of dependent claim 3, the method has the further steps of:

6) removing the physical object from the screen after step 5 (see page 6, lines 9-12); or

7) moving the physical object to a further designated area after step 5 for causing the electronic device to provide a message associated with the further designated area (see page 6, line 14-16).

In the invention of dependent claim 4, the method has the further step of:

8) removing the physical object from the screen after step 7 to cause the electronic device to carry out a command associated with the further designated area (see page 7, lines 16-17).

In the invention of dependent claim 5, the provided message comprises a text message (see page p.5, lines 26-27).

In the invention of dependent claim 6, the text message is displayed on the screen (see page p.5, lines 26-27).

The invention of claim 7 is directed to an electronic device capable of carrying out a plurality of commands. The electronic device has:

a screen having a plurality of designated areas for displaying a plurality of icons symbolizing the commands, so as to allow a user to interact with an icon by using a physical object to contact the screen at the corresponding designated area (see page 5, lines 8-15);

a sensing device, operatively connected to the screen to sense the contact of the screen by the physical object, for providing a signal in the electronic device indicative of said contacting (see page 6, lines 19-21), and

a software program, responsive to the signal, for carrying out further steps, such that if the physical object is removed from the screen after contacting said designated area but before a selected time has expired, said program carries out the command symbolized by said icon,

if the physical object is kept at said designated area longer than the selected time, said program provides a message associated with said command,

if the physical object is removed from the screen after the physical object is kept at said designated area longer than the selected time and the message is provided, said program carries out the symbolized command, and

if the physical object is moved off said designated area after the message is provided while the physical object is kept on the screen, said program ends the message (see page 6, line 21 to page 7, line 14).

In the invention of claim 9, the software program carries out the further step of:

if the physical object is moved to a further designated area after the physical object is moved off said designated area, the software program provides a further message associated with the further designated area (see page 7, lines 14-16).

In the invention of claim 10, when the physical object is removed from the screen after the physical object is moved to the further designated area, the software program carries out a command associated with the further designated area (see page 7, lines 16-17).

In the invention of claim 11, the message is provided in a text bubble displayed on the screen (see page 5, lines 26-28).

In the invention of claim 12, the electronic device also has an audio device so that the message is provided in an audible form via the audio device (see page 7, lines 28-30).

The invention of claim 13 is directed to a series of programming codes to be executed by a data processing module in an electronic device having a screen, the electronic device capable of carrying out a plurality of commands. The programming codes comprises:

- a code for generating a plurality of icons symbolizing the commands, the icons displayed at a plurality of designated areas on the screen so as to allow a user to interact with an icon by using a physical object to contact the screen at the corresponding designated area; and

- a code, responsive to said user interaction, for

- causing the electronic device to carry out the command symbolized by said icon, if the physical object is removed from the screen after contacting said designated area but before a selected time has expired, the electronic device is caused to carry out the command symbolized by said icon, and

- causing the electronic device to provide a message associated with said command, if the physical object is kept at said designated area longer than the selected time, and

- a code for causing the electronic device to carry out the symbolized command, if the physical object is removed from the screen after the physical object is kept at said designated area longer than the selected time and the message is provided, and causing the electronic device to end the message if the physical object is moved off said designated area after the help message is provided while the physical object is kept on the screen (see page 6, line 21 to page 7, line 14).

In the invention of claim 15, the programming codes further comprises:

- a code for causing the electronic device to provide a further message associated with a further designated area if the physical object is moved to the further designated area after the physical object is moved off said designated area (see page 7, lines 14-16).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR §41.37(c)(1)(vi))

Claims 1, 3-7, 9-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chew et al.* (U.S. Patent No. 6,664,991, hereafter referred to as *Chew*) in view of *Clark et al.* (U.S. Patent No. 5,995,101, hereafter referred to as *Clark*).

Claims 1, 7 and 13

In rejecting claims 1, 7 and 13, the Examiner states that *Chew* discloses an electronic device as claimed, the Examiner points to col. 3, lines 33-67, for discloses an electronic device capable of carrying out a command and providing a message associated with the command.

The Examiner states that *Chew* discloses **Step 1**: contacting the screen at the designated area by a physical object.

The Examiner points to col. 7, lines 1-8, to show that *Chew* discloses **Step 2** where the user may remove the physical object before the selected time has expired, so that the context menu is not displayed and the “stylus up event is dispatched to the application, and that tapping may cause selection of an entry. The Examiner admits that *Chew* does not explicitly mention that the input function is a command symbolized by an icon or that the stylus up event before the expiration of the selected time causes the command to be executed, but points to *Clark* for disclosing tool tips that are commonly associated with icons and that when a user selects the icon with a pointing device, the command associated with the icon is carried out (col.1, lines 10-14);

The Examiner points to col. 1, line 56 – col.2, line 9, to show that *Chew* discloses **Step 3**: providing the message if the contact is longer than a predetermined time duration;

The Examiner points to col. 1, lines 26-28 in *Clark* to show that *Chew* and *Clark* disclose **Step 4**: removing the physical object from the screen after the message is displayed to cause the electronic device to carry out the command. In particular, the Examiner states that *Clark* teaches selecting the icon at any time invokes the associated function.

The Examiner points to col.1, lines 61-65, to show that *Chew* discloses **Step 5**: moving the physical object off the desired area while keeping the physical object on the screen after displaying the message to end the message. The Examiner further points to col.4, lines 7-9, and col. 6-48-51 to show that *Chew* discloses that a context menu may be dismissed by taping a stylus and that a user drags the stylus outside the context menu in a “move gesture”. The Examiner states that it would be obvious to use this “move” gesture with any command related to a context menu, such as the closing of the context menu.

Claims 3, 9 and 15

In rejecting claims 3, 9 and 15, the Examiner points to the stylus event in *Chew* to show that *Chew* and *Clark* teach **Step 6**: removing the physical object from the screen after ending the display of the message.

The Examiner further points to Figure 3, item 300, in *Chew* and Figure 1 in *Clark* to show that *Chew* and *Clark* teach **Step 7**: moving the physical object to a further designated area after step 5 for causing the electronic device to provide a message associated with the further designated area.

Claims 4 and 10

In rejecting claims 4 and 10, the Examiner points to col.1, lines 26-28 in *Clark* to show that *Chew* and *Clark* teach **Step 8**: removing the physical object from the screen after step 7 to cause the electronic device to carry out a command associated with the further designated area.

Claims 5, 6, and 11

In rejecting claims 5, 6 and 11, the Examiner points to Figure 4, item 400, in *Chew* to show that *Chew* and *Clark* discloses a **text message** as the provided message.

Claim 12

In rejecting claim 12, the Examiner admits that *Chew* does not explicitly teach that the message is an audible form, but points to col. 2, lines 1-9, to show that *Clark* discloses that tool-tips may be presented as **audio**.

VII. ARGUMENT (37 CFR §41.37(c)(1)(vii))

(A) Claim 1

It is respectfully submitted that the invention as claimed in claim 1 is concerned with interacting with an icon on a touch screen in an electronic device, wherein the interacting includes the following steps:

Step 1: Contacting the screen at a designated area by the physical object, wherein the icon is displayed at the designated area of the touch screen to symbolize a command; and

Step 2: Removing the physical object from the screen before a selected time has expired to cause the electronic device to carry out the command, or

Step 3: Keeping the physical object at the designated area longer than the selected time to cause the electronic device to provide a message, wherein the message is associated with the command, and

Step 4: Removing the physical object from the screen after step 3 to cause the electronic device to carry out the command, or

Step 5: Moving the physical object off the designated area while keeping the physical object on the screen after step 3 to end the message.

The interaction between a user and a touch screen as claimed in claim 1 can be summarized as follows:

- (1) Contact – (2) Short contact: a command is carried out, or
 - (3) Long contact: a message associated with the command is provided, and
 - (4) Lift object: the command is carried out; or
 - (5) Sliding motion: end message.

From step 1 to step 4, only one contact is made. Likewise, from step 1 to step 5, one contact is made.

In rejecting claim 1, the Examiner cites *Clark* for disclosing icons (col.1, lines 10-14 – tool tips) and step 4 (col.1, lines 26-28 – selecting the icon at any time to invoke the associated function); the Examiner cites *Chew* for disclosing:

an electronic device capable of carrying out a command and providing a message associated with the command (col. 3, lines 33-67);

step 1 (contacting the screen);

step 2 (col. 7, lines 1-8 or the stylus up event);

step 3 (col. 1, line 56 – col.2, line 9); and

step 5 (col. 1, line 61-65; col. 4, lines 7-9 and col. 6, lines 48-51).

At issue here are:

- (i) whether *Clark* discloses an **icon** that can be used in the electronic device according to *Chew*;
- (ii) whether *Chew* discloses causing the electronic device to provide a message associated with a command when the physical object is kept at the designated area longer than the selected time as specified in **Step 3**;
- (iii) whether *Chew* and *Clark* disclose causing the electronic device to provide the command by removing the physical object from the screen after step 3 as specified in **Step 4**; and
- (iv) whether *Chew* and *Clark* disclose the selection, after step 3, between causing the electronic device to provide the command by removing the physical object from the screen as specified in **Step 4**, and ending the message by moving the physical object off the designated area while keeping the physical object on the screen as specified in **Step 5**.

(i) Icon

Clark does disclose tool tips. It is known in the art that tool tip is used to provide one-direction information, such as a short textual label that appears over an icon to provide a brief identification of the program function associated with the icon. However, the tool tip as disclosed in *Clark* is not compatible with the list of entries 300 or 700 as disclosed in *Chew*, because the list 300 or 700 of the entries or options in *Chew* is editable by a user.

(ii) Command and Message Associated with the Command

In Step 2 of claim 1, the electronic device is caused to carry out a command symbolized by an icon that is displayed at the designated area contacted by the physical object if the contact is short.

In Step 3, the electronic device is caused to provide a message associated with that command when the physical object is kept at the designated area longer than the selected time.

In order to determine whether *Chew* discloses Step 3, it is necessary to determine what designated area is involved, what command is symbolized by the icon displayed at that designated area, and what message is associated with the command.

The Examiner points to col.3, lines 33-67 to show that *Chew* discloses an electronic device capable of carrying out a command and providing a message associated with the command.

It is respectfully submitted that, at col. 3, lines 33-56, *Chew* only discloses how the electronic device 68 is constructed. At col.3, lines 57-67, *Chew* provides the general description of the invention as follows:

The present invention provides a means for identifying gestures made by the user that are intended to cause a hand-held pen-based device to display a context menu. In response to an identified gesture, the present invention notifies a parent application that the gesture occurred, thereby allowing the parent application to display a context menu if it wants to. If the parent application does not wish to display a context menu, the gesture is ignored and normal processing continues. In some embodiments, the parent application substitutes a tool tip or pop-up help for the context menu.

In the above paragraph, *Chew* discloses that a user may perform a gesture to cause the device to display a context menu. The “gesture” as described in the above paragraph is a context-menu gesture performed by the user by a stylus input (col. 1, lines 61 – 63) made with a tap-and-hold gesture (col. 4, lines 14-16). When these gestures are made, a context-menu appears (col. 1, lines 63-65).

As shown in Figure 3 and described in col. 4, lines 10-26, *Chew* discloses a display having a contact list 300 consisting of a set of entries, such as entry 302. If the user carries out a tap-and-hold gesture (context menu gesture) on an entry, a context menu 400 appears, the context menu 400 has a number of commands. The Examiner seems to suggest that each of the entries represents a designated area and placing the stylus to select the entries is equivalent to the step of contacting the screen at the designated area by the physical object as claimed.

Command Assigned to an Entry

If the area where the selected entry is located is the designated area, it is necessary to determine the command assigned to that entry and the message associated with that command. It is also necessary to determine whether the command is carried out if the tap-and-hold gesture is

shorter than a selected time and whether the message is provided if the tap-and-hold gesture is longer than the selected time.

According to *Chew*, a gesture made on an entry may or may not cause a context menu to appear. If the context menu gesture is complete as a result of a long stylus contact, a context menu would appear. If the stylus is lifted before the context menu gesture is complete, the user is not performing a tap-and-hold gesture and the context menu does not appear. Thus, according to *Chew*, if the contact is brief, nothing will happen. *Chew* fails to disclose that a command is carried out if the stylus contact is shorter than a selected time as specified in **Step 2**.

Because a command is not carried out if the stylus contact is brief, the tap-and-hold gesture cannot be considered as being equivalent to “contacting the screen at a designated area by a physical object” and the area occupied by an entry cannot be considered as the designated area.

Second Stylus Action

According to *Chew*, after a context menu is displayed in response to a tap-and-hold gesture, the user may make a second stylus action on one of the commands in the context menu in order to select that command.

If the second stylus action to select one of the commands in the context menu is considered as being equivalent to contacting the designated area by the physical object (Step 1), it is necessary to determine the result of a short second stylus action (Step 2) and the result of a long second stylus action (Step 3).

According to *Chew*, the user may select one of the commands appearing on the context menu by tapping the command with the stylus (Figure 5; col. 4, lines 27-33), or dismiss the context menu by tapping the stylus outside the context menu (Figure 6; col. 4, lines 33-35).

If “tapping” the command with the stylus in the second stylus action is considered as being equivalent to Step 2, it is necessary to determine whether *Chew* and *Clark* disclose Step 3: causing the electronic device to provide a message associated with the command if the stylus in the second stylus action is held on the selected command longer than the selected time.

The Examiner states that *Chew* discloses that a message associated with the command is provided if the contact is longer than a predetermined time duration (col.1, lines 56 to col. 2, line 9).

At col. 1, line 56 to col.2, line 9, *Chew* discloses:

The present invention provides a user interface for a pen-based device that allows users to activate the full "card" for an entry using a single tap while also giving the user the ability to reach a menu of context dependent commands using a simple gesture. In particular, the present invention recognizes certain stylus and/or button inputs as context menu gestures. When these gestures are made, a context menu appears. The user is then able to select a command in the context menu that is to be performed.

Under one embodiment, the gesture consists of pressing and holding the stylus on a selection for a system-specified length of time. If the user does not move the stylus more than a system specified distance from the original location for that time, a context menu gesture is recognized and the application displays a context menu. In other embodiments, pressing and holding an external button on the pen-based device while an entry is highlighted is considered a context menu gesture. In still further embodiments, double tapping the stylus or pressing and holding an external button while tapping the stylus are considered context menu gestures.

In the above paragraphs, *Chew* discloses how a context menu can be caused to appear by a tap-and-hold gesture and what the user can do after the context menu is displayed. As pointed out earlier, this tap-and-hold gesture or the context menu gesture is not the same as contacting the designated area by the physical object as Step 2, because a short contact or an incomplete tap-and-hold gesture is simply ignored by the electronic device and no command is carried out.

While *Chew* discloses that the user may select one of the commands appearing on the context menu by tapping the command with the stylus in the second stylus action, *Chew* does not disclose or suggest what would happen if the second stylus action is longer than a predetermined

time duration. Thus, *Chew* fails to disclose providing a message associated with the command if the second stylus action is longer than a predetermined time duration as specified in **Step 3**.

(iii) Command After the Message

According to claim 1, a message associated with a command is provided when the physical object is kept at the designated area longer than the selected time (Step 3) and the command is provided by the electronic device if the physical object is removed from the screen at Step 4. According to claim 1, the user contacts the designed area only once in order to carry out Step 4 from Step 1 via Step 3.

The Examiner points to col. 1, lines 26-28, to show that *Clark* discloses step 4 in which the command is carried out if the physical object is removed from the screen after the message is displayed – because the contact is longer than a predetermined time duration. In particular, the Examiner states that *Clark* discloses selecting an icon at any time to invoke the associated function.

At col. 1, lines 26-28, *Clark* discloses that when the user selects the icon with a pointing device, such as a mouse, the corresponding function of the computer program is invoked. According to *Clark*, the icon has a short textual label or “tool tip” which appears on the computer screen for a predetermined period of time (the “tool tip trigger interval” or “tool tip timeout interval”) when the user places a cursor over the icon (col.1, lines 18-26). If the user selects the icon within the predetermined period of time, a function is invoked. If the user has not selected the icon within the predetermined period of time, the tool tip disappears (col. 1, lines 26-33).

It is respectfully submitted that, in order to carry out a function associated with an icon according to *Clark*, two actions must be taken. First, the user must place the pointing device over the icon to cause the tool tip to appear. Second, the use must use the pointing device to select the icon within a predetermined period of time. Even if the pointing device can be replaced with a physical object, the user must uses the physical object twice in order to invoke a command or a function, according to *Clark*. First, the user must use the physical object to touch the icon to reveal the tool tip. Second, the user must touch the same icon again to invoke the associated function.

In contrast, at step 4 of the claimed invention, the command is carried out if the physical object is removed from the screen after a long contact that causes the display of a message.

There is only one contact from step 1, step 3 to step 4. There is no need for the user to touch the screen again after the message is displayed in order to carry out the command.

In *Chew*, no message associated with the command is provided if the user presses the stylus longer than a selected time. Even if the commands on the context menu are considered as messages, the user must tap a selected command in a second stylus action to carry out the command after the context menu is displayed (col.4, lines 27-32). *Chew* requires both a tap-and-hold gesture to reveal a context menu and a second stylus action to carry out a command.

Chew requires two stylus actions to carry out a selected command. *Clark* requires two actions to invoke a function. In contrast, the claimed invention requires only one screen contact to complete Step 4 from Step 1. Thus, *Chew* and *Clark*, whether in combination or individually, fails to disclose **Step 4**.

(iv) Termination of Message

In the claimed invention, after the message is displayed, it is possible to cause the electronic device to provide the command by removing the physical object from the screen (step 4), or ending the message by moving the physical object off the designated area while keeping the physical object on the screen (step 5). Thus, after one long screen contact, the user can select Step 4 or Step 5.

The Examiner points to col. 1, lines 61-65; col. 4, lines 7-9; and col. 6, lines 48-51, to show that *Chew* discloses step 5 in which the message is ended if the physical object is moved out of the designated area while keeping the physical object on the screen.

At col. 1, lines 61-65, *Chew* discloses:

In particular, the present invention recognizes certain stylus and/or button inputs as context menu gestures. When these gestures are made, a context menu appears. The user is then able to select a command in the context menu that is to be performed.

At col. 4, lines 7-9, *Chew* discloses:

The user can dismiss the context menu without making a selection. Under one embodiment, this is done by touching the stylus outside of the context menu.

As discussed with regard to sub-sections (ii) and (iii) above, the selection of a command in the context menu requires the user to make a second stylus action on one of the commands. At this point, the tap-and-hold gesture on an entry is already complete. According to *Chew*, if the user makes a second stylus action on the selected command, the function is invoked in response to the second stylus action. This indicates that the first stylus action is over and the stylus must be already off the screen in order to allow the user to make a second stylus action. Alternatively, if the user does not want to invoke any function in the context menu, the user may tap the stylus outside the context menu. With the second choice, the user may not place the physical object on the designated area of the commands within the context menu as a second stylus action.

In the claimed invention, after the user already places the physical object on the designated area longer than a predetermined period of time, the user may move the physical object out of the designated area while keeping the physical object on the screen to end the message (Step 5). *Chew* does not disclose this feature with the first stylus action. *Chew* does not disclose **Step 5**.

Selection Between Step 4 and Step 5

In the claimed invention, the user may remove the physical object off the screen to cause the electronic device to carry out the command (Step 4). Thus, the user can have a choice of step 4 or step 5 after the user already places the physical object on the designated area long than a predetermined period of time.

At col. 6, lines 48-51 and lines 54-59 *Chew* discloses:

As the user holds the stylus on the screen, the stylus may move slightly across the screen. This movement causes a stylus move event message to be posted to the queue. If the stylus has moved outside of the contact area, the user is probably trying to perform a drag operation and not a context menu gesture. In that case, the capturing of input events is stopped.

In the above passage, *Chew* suggests that it is possible to place the stylus on the screen without making a context menu gesture by a drag operation. This drag operation must be carried out in order to avoid the appearance of the context menu. Without the context menu and the commands on the context menu, the user cannot decide to carry out a selected command or to end a message associated with the selected command. Thus, this particular drag operation has nothing to do with Step 4 or Step 5.

Even if the drag operation is used after the display of the context menu, there are only two possible situations regarding the drag operation: 1) the stylus is not in the area of the selected command or 2) the stylus is already in the area of the selected command. The first situation is irrelevant to Step 5, because Step 5 requires the user to move the physical object off the designated area while keeping the physical object on the screen.

In the second situation, after the user places the stylus in the area of the selected command as a second stylus event, the function of the selected command is invoked. Even if the user can use a drag operation to move the stylus off the designated area of one of the commands to end the message, the user cannot avoid invoking the function (carrying out the command). As such, the user causes the electronic device to carry out step 4 before step 5. The drag operation does not allow the user to select between step 4 and step 5. Thus, *Chew* fails to disclose carrying out **Step 5** without also carrying out **Step 4**.

Chew, in View of *Clark*, Fails to Render Claim 1 Obvious

In sum, even if the tool tip as disclosed in *Clark* can be used in the electronic device as disclosed in *Chew*, *Chew* and *Clark* do not disclose Step 2, Step 3 and Step 4 of the claimed invention. Furthermore, *Chew* and *Clark* do not disclose or suggest that the user is able to select between Step 4 and Step 5.

Thus, *Chew*, in view of *Clark*, fails to render the claimed invention in claim 1 obvious.

(B) Claims 7 and 13

The electronic device, according to claim 7, has a software program to carry out the method steps 2 to 5 of claim 1. The series of programming codes to be executed by a data

processing module, according to claim 13, includes programming codes to carry out the method steps 2 to 5 of claim 1. The Examiner rejects claims 7 and 13 for the same reasons.

Chew, in View of Clark, Fails to Render Claims 7 and 13 Obvious

For reasons regarding claim 1 above, it is respectfully submitted that *Chew*, in view of *Clark*, fails to render the claimed invention in claims 7 and 13 obvious.

(C) Claims 3, 9 and 15

In the invention of dependent claim 3, after moving the physical object off the designated area while keeping the physical object on the screen to end the message in step 5, without causing the electronic device to carry out the command in step 4, the user has a choice of removing the physical object from the screen (step 6) or moving the physical object to a further designated area for causing the electronic device to provide a message associated with the further designated area (step 7).

In rejecting claim 3, the Examiner points to the stylus up event (col. 7, lines 1-8) in *Chew* to show that *Chew* and *Clark* disclose step 6. The Examiner points to Figure 3 in *Chew* and Figure 1 in *Clark* to show that *Chew* and *Clark* disclose a plurality of selectable areas and icons which can be considered as further designated areas.

It is respectfully submitted that, at col.7, lines 1-8, *Chew* discloses that the user may also lift the stylus before the context menu gesture is completed. This stylus up event causes the dispatch of the event to the parent application at step 1208 and the method to end at step 1212. Here, the event is the input event obtained from the application queue at step 1204 related to SHRecognizeGesture 1108. As disclosed in *Chew*, when input device 1100 receives the input messages from a user, application 1106 calls SHRecognizeGesture 1108 to determine if the input is part of the context menu gesture. If the input message completes a context menu gesture, SHRecognizeGesture notifies parent application 1106 that a context menu gesture was received and the location of the stylus, if appropriate. Parent application then decides whether it will display a context menu. See col. 4, line 67 to col. 5, line 21.

According to this description of Figure 11, all these steps take place before a context menu is displayed. In order to produce a context menu, the stylus must be held in place for a predetermined period of time (col. 5, lines 22-29). If the stylus is removed from the contact area

(on one of the entries) before the predetermined period of time has passed (that is, before the context menu gesture is completed), the parent application may decide whether to display a context menu. It is clear that this stylus event is part of the context menu gesture. This means that the stylus up event has nothing to do with the selection of the commands in the context menu, because the context menu is not displayed if the context menu gesture is not completed. Accordingly, the stylus up event has nothing to do with the second stylus action that is used to select one of the commands on the context menu.

Chew, in View of Clark, Fails to Render Claim 3 Obvious

For the above reasons, the stylus up event is not the same as step 6 of the claimed invention where the physical object is already placed at one of the designated areas.

Furthermore, claim 3 is dependent from claim 1 and recites features not recited in claim 1. For the reasons regarding claim 1 above, claim 3 is also distinguishable over the cited *Chew* and *Clark* references.

Chew, in View of Clark, Fails to Render Claims 9 and 15 Obvious

The electronic device, according to claim 9, has a software program to carry out the method step 7 of claim 1. The series of programming codes to be executed by a data processing module, according to claim 15, include programming codes to carry out the method step 7 of claim 1. The Examiner rejects claims 9 and 15 for the same reasons as those in rejecting claim 3.

For reasons regarding claim 3 above, it is respectfully submitted that *Chew*, in view of *Clark*, fails to render the claimed invention in claims 9 and 15 obvious. Furthermore, claims 9 and 15 are dependent from claim 7 and 13 and recite features not recited in claims 7 and 13. For reasons regarding claims 7 and 13 above, claims 9 and 15 are also distinguishable over the cited *Chew* and *Clark* references.

(D) Claims 4-6 and 10-12

As for dependent claims 4-6 and 10-12, they are dependent from claims 1, 7 and 13 and recite features not recited in claims 1, 7 and 13. For reasons regarding claims 1, 7 and 13 above, claims 4-6 and 10-12 are distinguishable over the cited *Chew* and *Clark* references.

VIII CLAIMS APPENDIX (37 CFR §41.37(c)(1)(viii))

1. A method of interacting with an icon displayed on a touch screen in an electronic device, the electronic device capable of carrying a command symbolized by the icon and further capable of providing a message associated with the command, wherein the icon is displayed at a designated area of the screen so as to allow a user to interact with the icon by using a physical object, said method comprising the steps of:

- 1) contacting the screen at the designated area by the physical object; and
- 2) removing the physical object from the screen before a selected time has expired to cause the electronic device to carry out the command, or
- 3) keeping the physical object at the designated area longer than the selected time to cause the electronic device to provide the message, and
- 4) removing the physical object from the screen after step 3 to cause the electronic device to carry out the command, or
- 5) moving the physical object off the designated area while keeping the physical object on the screen after step 3 to end the message.

2. (canceled)

3. The method of claim 1, further comprising the step of:

- 6) removing the physical object from the screen after step 5; or
- 7) moving the physical object to a further designated area after step 5 for causing the electronic device to provide a message associated with the further designated area.

4. The method of claim 3, further comprising the step of:

- 8) removing the physical object from the screen after step 7 to cause the electronic device to carry out a command associated with the further designated area.

5. The method of claim 1, wherein the provided message comprises a text message.

6. The method of claim 5, wherein the text message is displayed on the screen.

7. An electronic device capable of carrying out a plurality of commands, comprising:
- a screen having a plurality of designated areas for displaying a plurality of icons symbolizing the commands, so as to allow a user to interact with an icon by using a physical object to contact the screen at the corresponding designated area;
 - a sensing device, operatively connected to the screen to sense the contact of the screen by the physical object, for providing a signal in the electronic device indicative of said contacting, and
 - a software program, responsive to the signal, for carrying out further steps, such that
 - if the physical object is removed from the screen after contacting said designated area but before a selected time has expired, said program carries out the command symbolized by said icon,
 - if the physical object is kept at said designated area longer than the selected time, said program provides a message associated with said command,
 - if the physical object is removed from the screen after the physical object is kept at said designated area longer than the selected time and the message is provided, said program carries out the symbolized command, and
 - if the physical object is moved off said designated area after the message is provided while the physical object is kept on the screen, said program ends the message.
8. (canceled)
9. The electronic device of claim 7, wherein
 - if the physical object is moved to a further designated area after the physical object is moved off said designated area, said program provides a further message associated with the further designated area.
10. The electronic device of claim 9, wherein
 - when the physical object is removed from the screen after the physical object is moved to the further designated area, said program carries out a command associated with the further designated area.

11. The electronic device of claim 7, wherein the message is provided in a text bubble displayed on the screen.

12. The electronic device of claim 7, further comprising an audio device so that the message is provided in an audible form via the audio device.

13. A series of specific operational steps expressible in a plurality of computer codes to be executed by a data processing module in an electronic device having a screen, the electronic device capable of carrying out a plurality of commands, said series comprising:

- a code for generating a plurality of icons symbolizing the commands, the icons displayed at a plurality of designated areas on the screen so as to allow a user to interact with an icon by using a physical object to contact the screen at the corresponding designated area; and

- a code, responsive to said user interaction, for

- causing the electronic device to carry out the command symbolized by said icon, if the physical object is removed from the screen after contacting said designated area but before a selected time has expired, the electronic device is caused to carry out the command symbolized by said icon, and

- causing the electronic device to provide a message associated with said command, if the physical object is kept at said designated area longer than the selected time, and

- a code for causing the electronic device to carry out the symbolized command, if the physical object is removed from the screen after the physical object is kept at said designated area longer than the selected time and the message is provided, and causing the electronic device to end the message if the physical object is moved off said designated area after the help message is provided while the physical object is kept on the screen.

14. (canceled)

15. The series of claim 13, further comprising

a code for causing the electronic device to provide a further message associated with a further designated area if the physical object is moved to the further designated area after the physical object is moved off said designated area.

IX. EVIDENCE APPENDIX (37 CFR §41.37(c)(1)(ix))

There are no evidences submitted pursuant to 37 CFR §1.130, 1,131 or 1,132.

X. RELATED PROCEEDING APPENDIX (37 CFR §41.37(c)(1)(x))

There are no prior decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR §41.37(c)(1)(ii).

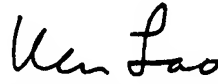
CONCLUSION

It is respectfully submitted that the present invention as claimed is readily distinguishable over the cited *Chew* and *Clark* references. Appellant's invention is not disclosed in the applied prior art and there is no fair basis for alleging that appellant's invention is obvious in regard to such art.

In view of the above, it is respectfully submitted that the rejection of claims 1, 3-7, 9-13 and 15 are in error and must be reversed. Such reversal is earnestly solicited.

Respectfully submitted,

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